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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/651,130

08/30/2000

Kent Malmgren

1010315-000092

1064

21839

7590

07/21/2008

BUCHANAN, INGERSOLL & ROONEY PC
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

07/21/2008

ELECTRONIC

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RECORD OF ORAL HEARING
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KENT MALMGREN,
SHABIRA ABBAS,
BENGT WIBBERG,
ASA OSTMAN,
and JEANETTE ANNERGREN

Appeal 2008-2394
Application 09/651,130
Technology Center 1700

Oral Hearing Held: June 11, 2008

Before EDWARD C. KIMLIN, CATHERINE Q. TIMM, and
KAREN M. HASTING, Administrative Patent Judges

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1 The above-entitled matter came on for hearing on Wednesday,
2 June 11, 2008, commencing at 1:09 p.m., at the U.S. Patent and Trademark
3 Office, 600 Dulany Street, Alexandria, Virginia, before Victoria L. Wilson,
4 Notary Registration No. 269770, Notary Public.

5 THE CLERK: Good afternoon. This is calendar number 15,
6 Appeal Number 2008-2394. The attorney is Mr. William Rowland.

7 JUDGE KIMLIN: Good afternoon, Mr. Rowland.

8 MR. ROWLAND: Good afternoon. How are you?

9 JUDGE KIMLIN: Introduce you to Vicky Wilson is our
10 transcriber today. And you can begin when you are ready, approximately 20
11 minutes --

12 MR. ROWLAND: Okay. Thank you.

13 JUDGE KIMLIN: -- if you need it.

14 MR. ROWLAND: I have been first in line before but I have
15 never been the only person.

16 JUDGE HASTINGS: I know. Everybody else canceled today.

17 MR. ROWLAND: Anyway, the invention in the application
18 relates to a material having multi-functional absorption properties. These
19 include acquisition, distribution and storage, and these absorption properties
20 are useful in absorbing products such as in diapers or other hygiene
21 products.

22 The acquisition is used to take the fluid in quickly so it doesn't
23 spill over the edges or the sides of the product. Distribution is used to move
24 the fluid once it's acquired evenly throughout the product so it can be
25 absorbed in an effective way. And storage, of course, relates to the amount
26 of fluid that can be stored.

27 Traditionally these three products -- these three properties are

1 accomplished by different layers of different materials. One of the ideas in
2 the present invention is to have a product that effectively does all three
3 functions so that you can just use one material, simplifying costs of
4 manufacturing.

5 JUDGE KIMLIN: Excuse me. Are there any known prior art
6 diapers or materials that use just one layer?

7 MR. ROWLAND: I wouldn't say one layer as much as one
8 absorbent product.

9 JUDGE KIMLIN: And are these three recited properties
10 known result effective variables in the art? They seem to be properties that
11 would seem to be of obvious interest to anyone making an absorbent article
12 in terms of absorption rate and capacity.

13 MR. ROWLAND: Yes, they are. The properties that I
14 described are known result effective variables.

15 There is a couple of factors. One is that these results can have
16 competing interests on the product. In other words, if you want to increase
17 the absorption rate, you might affect the overall storage capacity. They may
18 be inversely proportional. So it is not obvious to just modify the product to
19 increase all of the variables in a positive way.

20 JUDGE KIMLIN: So are you saying at the time of filing this
21 application, it was known that if you wanted a greater absorption rate, you
22 were going to lose some capacity?

23 MR. ROWLAND: I wouldn't think so but I can't say for
24 certain. That's my understanding, yes.

25 JUDGE KIMLIN: Uh-huh.

26 MR. ROWLAND: The other half of my answer is that the
27 invention in the claim is not quite as simple as acquisition, distribution and

1 storage. For example, the -- one of the traits is defined as liquid distribution
2 capacity, which includes having the sample held at an angle, and so they are
3 not -- the claimed elements are not exactly the three criteria that I just
4 described earlier.

5 This invention helps to create a product that takes into account
6 certain uses of the absorbant products. For example, the liquid distribution
7 capacity, as I mentioned, has an angle component to it so this takes into
8 account that users of the product may be lying down on their side as opposed
9 to standing completely upright.

10 The storage capacity is measured with the centrifuge retention
11 capacity test, although, of course, we are not centrifuging babies wearing
12 diapers. It takes into account the fact that babies can be active, falling down,
13 things that might otherwise affect the ability of the product to retain liquid.

14 So the long answer to your question is these are result known --
15 the results are known and desired but it is not that simple to put them
16 together in a useful product.

17 JUDGE KIMLIN: Do you agree with the examiner that the
18 applied reference Chen generally describes processing conditions that
19 correspond to your processing conditions -- admitting, of course, that the
20 reference doesn't teach these properties?

21 MR. ROWLAND: Right. I would say broadly no, and in part
22 because it doesn't result in the same product that we have.

23 JUDGE KIMLIN: Well, in terms of the steps that the examiner
24 recited in the rejection, like step A, B, C, that correspond to how you make
25 the product yourself, was there any error in the examiner's factual
26 determination that these steps correspond to your steps?

27 MR. ROWLAND: From my recollection, I don't recall any

1 specific error, although it did seem from my memory that the examiner was
2 sort of picking and choosing through a rather lengthy document various
3 process steps as opposed to looking in one section of the reference and
4 seeing a complete description of the manufacturing process and -- yes, so I
5 didn't really see a specific error.

6 JUDGE KIMLIN: And let me ask you this: Is there a
7 particular way you make your product that is different than one skilled in the
8 art would make the product of Chen that results in having different
9 properties?

10 MR. ROWLAND: If I recall, there are several examples in our
11 description of how the product is made, which results in the claimed
12 invention. So yes, I would say that it is.

13 JUDGE KIMLIN: I mean, could you point to one or two
14 process steps or operating parameters, like temperature, pressure, agitation
15 rate or anything along that line that is done to accomplish this heretofore
16 unknown balancing of optimum properties?

17 MR. ROWLAND: It is possible that one of the inventors could.
18 At this time I can't, unfortunately. But to answer -- finish my answer to your
19 last question, of course, we don't want to take the position that the invention
20 is limited to the disclosed embodiments in the application.

21 JUDGE KIMLIN: Meaning --

22 MR. ROWLAND: That there may be other ways you can make
23 an absorbant product that would meet the claimed terms other than the actual
24 embodiments set out in the specification.

25 JUDGE KIMLIN: I understand. Sure. You are interested in
26 the product itself.

27 MR. ROWLAND: The claims that each require an open cell

1 polymeric foam material having four criteria that are set forth in each of the
2 claims: Absorption rate, liquid distribution capacity, liquid storage capacity
3 and gel liquid absorption.

4 And of course, further details are in the claims, but just those
5 are the four basic function -- results that the -- or criteria that the foam
6 material should have.

7 The examiner has made an anticipation rejection under Chen,
8 and I would like to address that first.

9 He argues that there is a prima facie case of anticipation relying
10 primarily on Chen's disclosure of pores of 3,000 micrometers or less, and
11 there are two sections in the MPEP that I think refute the examiner's -- are
12 used to refute the examiner's rejection.

13 Section 2112.01 states, among other things, that a prima facie
14 case of anticipation can be rebutted by evidence showing that prior art
15 products do not necessarily possess the claimed characteristics.

16 And in this case, we filed a declaration by one of the inventors,
17 Mr. Malmgren, where he had reviewed Chen carefully and identified the
18 embodiment in Chen that he felt was closest to the present invention, and he
19 reconstructed that and tested it.

20 And in his declaration, he includes his test results showing that
21 even the closest embodiment of Chen doesn't have the claimed
22 characteristics. So I think that is certainly rebuttal evidence that Chen does
23 not necessarily possess the claimed characteristics as the examiner alleged.

24 JUDGE KIMLIN: How was it determined that example 3 of
25 Chen was the closest example?

26 MR. ROWLAND: I recall that it was in one of the papers that
27 was filed. Unfortunately, I don't remember the exact analysis.

1 JUDGE HASTINGS: I think it was the only example made
2 with CMC and the examples in your case are made with CMC.

3 MR. ROWLAND: That may have been the case.

4 JUDGE HASTINGS: That's what the brief says.

5 MR. ROWLAND: I remember reading the explanation; I don't
6 remember what it was. Thank you.

7 JUDGE HASTINGS: Yes, at the bottom of page 5 of your
8 brief it says: There is one example in Chen... Example 3 is the most
9 reasonable choice because of the use of carboxymethylcellulose, an anionic
10 polymer, and freeze drying and crosslinking - which are all steps and
11 materials used in your process. That's what your brief says.

12 MR. ROWLAND: I don't know if that's the only reason but
13 that's certainly one of the reasons.

14 The examiner refused to give much weight to the declaration,
15 saying, among other things, that the declaration was an opinion by someone
16 of interest, and to that we responded that this declaration is based primarily
17 on facts of a reconstruction of the product and an analysis of the result of the
18 testing.

19 So it is our position that merely isn't opinion, more of a
20 recitation of facts prepared by one of skill in the art. So we believe that that
21 position of the examiner has been successfully rebutted by at least the
22 declaration.

23 Another point in the MPEP that we rely on for support is
24 section 2131.03, which talks about claimed ranges falling within disclosed
25 ranges, and that section of the MPEP requires that the subject matter be
26 disclosed with sufficient specificity.

27 And the one example they give in the section talks about prior

1 art having a temperature range of 100 to 500 degrees, and the -- in fact, in
2 the cited example, they said it was -- there was, in addition to the disclosed
3 range of 100 to 500 degrees, there was a preferred disclosed range of 150 to
4 350 degrees, and in that case, the claimed range was 330 to 450.

5 And the Court of Appeals for the Federal Circuit in the case
6 referred to in the MPEP found that that disclosed range was too broad -- it
7 didn't recite the claimed range with sufficient specificity.

8 In contrast to that case, Chen's closest disclosed range is off by
9 more than six times. He talks about our claim has three micrometers and
10 Chen's lowest specifically disclosed range is 20 micrometers.

11 So I think from looking at Chen as a whole, it would be clear to
12 one of skill in the art that Chen did not clearly envision the claimed range of
13 zero to three micrometers. So --

14 JUDGE HASTINGS: The examiner's response to that -- I just
15 want to get your response to his response -- the examiner's response is that in
16 Chen, it talks about an embodiment where the porosity should have a
17 gradient and it should be open pores near one surface of the absorbant article
18 all the way to a substantially impervious surface at the other side of the
19 article.

20 And so the examiner's position is that if you are going to go
21 from an open-pored surface down to a substantially impervious side, then
22 inherently, you are obviously going to go below three microns.

23 MR. ROWLAND: I don't remember the language of an
24 impervious side. Typically these products do have some kind of an
25 impermeable layer behind the absorbant core. It may very well be in there.
26 I don't recall that specifically.

27 JUDGE HASTINGS: The Examiner referred to column 15,

1 lines 23 plus of the Chen reference where the absorbant fiber structure can
2 have gradients and pore size. For example, it can have large cells near a top
3 surface with cells that become progressively smaller near the opposing back
4 surface optionally terminating in the skin, which can be partially or
5 substantially liquid-impervious.

6 MR. ROWLAND: Well, I guess to that I would say a couple
7 things. One, that's sort of a teaching away from the present invention, the
8 goal of which I stated earlier was to have a single layer. It doesn't say
9 uniform layer but that was an idea of simplifying the manufacturing step.

10 So to go with something like Chen where he is talking about a
11 layer with gradient pores is a more complex material.

12 Also, since it is a gradient --

13 JUDGE KIMLIN: Excuse me, Mr. Roland. Do your claims
14 exclude gradient pores?

15 MR. ROWLAND: No. No.

16 JUDGE HASTINGS: You have two distributions of pores.

17 MR. ROWLAND: But secondly, because of the gradient in
18 Chen, I am not sure how that would impact on the -- some of the claimed
19 criteria, including the percentage of small pores. If it is a gradated layer, the
20 very small pores would, of course, be just a small proportion of the material
21 and not uniformly distributed throughout.

22 JUDGE HASTINGS: Are your pores uniformly distributed
23 throughout?

24 MR. ROWLAND: It is not a necessary requirement, no. But
25 again, I'm going to the fact that Chen doesn't teach the proportion, not the
26 uniform distribution.

27 So anyway, for those -- at least those two reasons, it is our

1 position that Chen does not anticipate the claims.

2 With regard to obviousness, the examiner hasn't put down a lot
3 of argument outside of the anticipation. It is our position that Chen certainly
4 doesn't teach the ability or desirability of combining these four claimed
5 criteria in one product.

6 So it not only doesn't anticipate it but there is nothing -- since
7 he doesn't teach the desirability of it, there would be nothing to suggest or
8 motivate one to go and try and assemble those four claimed criteria.

9 I would also -- since this case was briefed, of course, the patent
10 office came out with the KSR guidelines and it might be appropriate to touch
11 on those briefly.

12 The patent office guidelines talk about seven different
13 rationales for forming an obviousness rejection. In this case, rationales A
14 through D would not apply because they are primarily concerned with
15 combining known prior art.

16 Rationale E is the obvious to try. That, obviously, was not
17 discussed by the examiner at the time. And with regard to a potential basis
18 on rationale E, nothing in the record provides a showing of at least points 2
19 and 3, point 2 being a finite number of identified predictable solutions and 3
20 being a reasonable expectation of success.

21 With regard to rationale F, known work in one field of
22 endeavor may prompt variations of it, there is no showing in the record of at
23 least point 3, which is a finding that the differences between the claimed
24 invention and the prior art were encompassed in known variations or in a
25 principal known in the prior art.

26 And with regard to rationale G, which is some teaching,
27 suggestion or motivation to modify prior art, there is no showing of at least

1 points 1 and 2, point 1 being teaching, suggestion or motivation to modify
2 the reference.

3 With regard to that point, I think the examiner improperly
4 attempts to shift the burden to the applicant when he states, The applicants
5 have failed to provide evidence that the absorbant properties of Chen
6 necessarily cannot be optimized.

7 Point 2, no showing of reasonable expectation of success.
8 Here, that's an important point in view of the previously discussed issue of
9 the fact that the claimed parameters are somewhat competing with each
10 other. In other words, if you modify one of the claimed parameters, you
11 may deteriorate another of the claimed parameters.

12 JUDGE TIMM: Was that known in the art, that there was this
13 tradeoff in properties?

14 MR. ROWLAND: I can't say for sure but I would suspect yes,
15 that that was known.

16 So for those reasons we argue that the claims are not obvious
17 over Chen.

18 JUDGE KIMLIN: Any further questions?

19 JUDGE TIMM: No further questions.

20 JUDGE KIMLIN: All right. We understand your position.
21 Thank you for coming.

22 MR. ROWLAND: Thank you very much.

23 Whereupon, the proceedings at 1:28 p.m. were concluded.